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In view of the fact that both the Examiner Interview Summary Record dated January 24, 1996 (telephone discussion with Examiner Schwartz), and the Examiner Interview Summary dated February 15, 1996 (telephone discussion with Examiner Weber), indicate that agreement was reached and that the rejections of record would be withdrawn, there is no apparent need to burden the record with further discussion thereon. Moreover, note that each of the Examiner Interview Summary Records indicate that it is not necessary for Applicant to provide a separate record of the substance of the interview. Nonetheless, in the interest of providing a full written record, Applicants provide the following comments.

In accordance with the present invention, there are provided methods to modulate processes mediated by retinoid receptors, employing highly specific ligands for such receptors. Invention methods can be employed for treatment of a variety of conditions, e.g., for the treatment of premalignant or precancerous epithelial lesions (thereby retarding the progression thereof into carcinomas), for the treatment of tumors of epithelial origin (thereby retarding the development of such tumors), and the like.

Clarification of the record is respectfully requested. At page 2 of Paper No. 13, it is noted that an unexecuted declaration filed 21 August 1995 has been received and entered. While an unexecuted declaration was initially submitted (on 11 August 1995), a fully executed declaration was hand-delivered to the Group 1800 receptionist on 21 August 1995. Thus, it is respectfully requested that the record be corrected to reflect

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the timely submission of a fully executed declaration on 21 August 1995.

The restriction of claims 30-53 under 35 U.S.C. § 121, is respectfully traversed. It is respectfully submitted that no serious burden is imposed on the Examiner to consider the asserted claims together in a single application as all claims deal with the use of the same active agent (9-cis retinoic acid or defined derivatives thereof) to modulate the activity of the same target (retinoid receptors). Moreover, the Examiner has failed to establish that the Groups set forth for restriction have actually acquired a separate status in the art as Groups I-VII are all characterized as being classified in Class 514, subclass _____. Even more nondescript, Group VIII claims are characterized as being classified in Class ____, subclass _____.

In order to be fully responsive, the election of Group III (claims 36-40 and 51-52) with traverse, is hereby affirmed.

Applicants respectfully disagree with the Examiner's assertion that the present application is not entitled, under 35 U.S.C. § 120, to the benefit of the filing date of parent application USSN 07/809,980. As acknowledged by the Patent and Trademark Office (in numerous telephone discussions with Biotechnology Practice Specialist, Richard Schwartz, and confirmed in follow up telephone discussions with Examiner Jon Weber, the most recent of which was held on 15 February 1996), the disclosure of the priority document is respectfully submitted to be adequate to support the claim of priority in the present application under 35 U.S.C. § 120. Indeed, in the Examiner Interview Summary dated 15 February 1996, Examiner Weber notes

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that "the rejection under § 112, first paragraph and rejections based on lack of benefit of priority under 35 U.S.C. § 120 would be withdrawn...". Accordingly, reconsideration and withdrawal of the denial of the claim for priority based on USSN 07/809,980 is respectfully requested.

The rejection of claims 36-40 and 51-52, and the objection to the specification under 35 U.S.C. § 112, first paragraph, as allegedly failing to provide an enabling disclosure, is respectfully traversed. As acknowledged by the Patent and Trademark Office (in numerous telephone discussions with Biotechnology Practice Specialist, Richard Schwartz, and confirmed in follow up telephone discussions with Examiner Jon Weber, the most recent of which was 15 February 1996), the present disclosure is respectfully submitted to fully comply with the enablement requirement of 35 U.S.C. § 112, first paragraph. Indeed, in the Examiner Interview Summary Record dated January 24, 1996, Examiner Schwartz asserts that "Claim 51 appears to be enabled... interference could proceed with this claim...". Moreover, as noted by Examiner Weber in the 15 February Examiner Interview Summary, "the prospective interfering claims are sufficiently enabled when one considers the state of the art at the time of filing...". Accordingly, reconsideration and withdrawal of the rejection/objection under § 112, first paragraph, is respectfully requested.

The rejection of claims 36-40 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Applicants respectfully disagree with the Examiner's assertion with the term "modulation", as employed in claim 36, is vague and indefinite. It is respectfully submitted that the term "modulate" is well

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understood by those of skill in the art. Indeed, as acknowledged by the Examiner at page 11, line 11 of Paper No. 13, "modulation could be inhibition or enhancement" (emphasis added), and is, therefore, a readily understood term to those of skill in the art.

Applicants also disagree with the Examiner's assertion that claim 38 recites an improper Markush group. It is respectfully submitted that claim 38, as written, employs an acceptable alternative format for Markush claims. The "proper format" set forth by the Examiner at page 11, line 18 of Paper No. 13 is not the only format recognized by the Patent and Trademark Office for such claims. See, for example, MPEP 2173.05(h)(b).

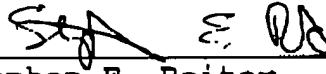
The rejections over the prior art, which are asserted at page 11, lines 20-22 of Paper No. 13, to be "based upon the determination that priority to 07/809,980 is not being accorded for the purposes of prior art considerations", are respectfully submitted to be irrelevant in view of the acknowledgement by the Patent and Trademark Office that Applicants' specification is entitled to the priority date of USSN 07/809,980. Indeed, the PTO has already acknowledged the patentability of the claimed subject matter by issuing substantially the same claims in U.S. Patent No. 5,428,071, issued 27 June 1995, to Bollag et al., based on an application with a later effective filing date than the priority date of the present application. Accordingly, reconsideration and withdrawal of the art-based rejections is respectfully requested.

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In view of the above remarks, reconsideration and withdrawal of all rejections of record is respectfully requested so this application can promptly proceed before the Patent and Trademark Office Board of Interferences. In the event there are any further issues to be resolved prior to initiating the interference procedure, the Examiner is invited to call the undersigned at the telephone number provided herein so that further processing of this application can expeditiously proceed.

Respectfully submitted,

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